

Appl. No.: 10/661,822
Amdt. dated October 13, 2008
Reply to Office Action of June 11, 2008

REMARKS/ARGUMENTS

This Response is filed in response to the Office Action dated June 11, 2008. In the response, the Examiner indicated on page 2 of the Office Action that the Information Disclosure Statement (IDS) filed on October 25, 2004, fails to comply with 37 CFR § 1.98(a)(2), which requires a legible copy of each cited foreign patent document. In response, Applicants are resubmitting, on the attached form PTO-1449 (see Appendix A), Japanese reference number 05-165847, along with a copy of the cited document. Applicants listed this reference on form PTO-1449 in an Information Disclosure Statement, filed on October 25, 2004, in the above-referenced application, but Applicants inadvertently failed to enclose a copy of the document. The Examiner subsequently did not consider this reference due to Applicants' failure to comply with § 1.98(a)(2).

It is requested that the Examiner consider this document and officially make it of record in accordance with the provisions of 37 C.F.R. § 1.97 and Section 609 of the MPEP. By identifying the listed document, Applicants in no way make any admission as to the prior art status of the listed document, but are instead identifying the listed document for the sake of full disclosure.

In addition, on page 2 of the Office Action, independent Claims 9 and 18 and dependent Claims 10-11, 14-16, and 19-20 were rejected under 35 U.S.C. § 103(a) as obvious in light of U.S. Patent Publication No. 2002/0010689 to *Tibbs et al.* ("*Tibbs*") in view of U.S. Patent Publication No. 2002/0013744 to *Tsunenari et al.* ("*Tsunenari*"). Additionally, dependent Claims 12-13 were rejected under § 103(a) as obvious in light of *Tibbs* in view of *Tsunenari* and in further view of www.buy.com. In response, Applicants have amended independent Claims 9 and 18 and dependent Claims 10-11 and 14-16. Applicants have included below arguments in support of independent Claims 9 and 18 as amended. Following this Response, Claims 1-22 remain pending in the application, and Claims 1-8, 17, 21, and 22 are withdrawn.

A. Rejection of Independent Claim 9 and Dependent Claims 10-16 under § 103(a) in light of *Tibbs* in view of *Tsunenari*

In response to the rejection of independent Claim 9 under § 103(a) as being obvious in light of *Tibbs* in view of *Tsunenari*, Applicants have amended independent Claim 9 to recite that at least the recorded date and time that the return-shipping label is made available for the customer's use are stored with the return-shipping label data on the service provider computer. Additionally, Applicants have amended Claim 9 to recite the steps of: (1) making available to the merchant at least the recorded time and date the return-shipping label was made available for the customer's use; (2) recording, by the service provider computer, at least the date and time of a customer's network request to retrieve the return-shipping label; and (3) making available to the merchant at least the recorded date and time of the network request.

Applicants respectfully assert that these steps are not disclosed in the prior art references cited by the Examiner. In particular, *Tibbs* discloses receiving a network request to retrieve a return-shipping label, but *Tibbs* does not disclose recording a date and time of the network request or making the date and time of the network request available to the merchant. *Tsunenari* discloses making a return-shipping label available to a customer through a merchant's website and recording the time and date a return-shipping label is made available to the customer. However, *Tsunenari* does not disclose storing the time and date on a service provider computer and making the time and date available to the merchant. Accordingly, Applicants respectfully assert that independent Claim 9 as amended is not obvious in light of *Tibbs* in view of *Tsunenari*. Therefore, Applicants request that the current rejection of independent Claim 9 under § 103(a) be withdrawn.

Dependent Claims 10-16 depend from independent Claim 9 and include all of the recitations of Claim 9 and any intervening claims plus their additional recitations that further distinguish the art applied in the rejection. Thus, for at least the reasons set forth above with respect to independent Claim 9, it is respectfully submitted that dependent Claims 10-16 are further patentable over the references cited as such dependent claims now depend from an allowable base claim. Accordingly, Applicants respectfully request that the current rejections of dependent Claims 10-16 under § 103(a) also be withdrawn.

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B. Rejection of Independent Claim 18 and Dependent Claims 19-20 under § 103(a) in light of *Tibbs* in view of *Tsunenari*

In response to the rejection of independent Claim 18 under § 103(a) as being obvious in light of *Tibbs* in view of *Tsunenari*, Applicants have amended Claim 18 to recite that the service provider computer records at least the date and time that the notification is made to the customer indicating that the return-shipping label is ready for download. Applicants have also amended Claim 18 to recite the steps of: (1) storing, with the return-shipping label data, at least the recorded date and time that the notification was made to the customer and (2) making available to the merchant computer via the service provider computer at least the recorded date and time that the notification was made to the customer. As discussed above in relation to independent Claim 9, the prior art does not disclose these features. Accordingly, Applicants respectfully assert that independent Claim 18 as amended is not obvious in light of *Tibbs* in view of *Tsunenari*. Therefore, Applicants respectfully request that the current rejection of independent Claim 18 under § 103(a) be withdrawn.

Dependent Claims 19-20 depend from independent Claim 20 and include all of the recitations of Claim 18 and any intervening claims plus their additional recitations that further distinguish the art applied in the rejection. Thus, for at least the reasons set forth above with respect to independent Claim 18, it is respectfully submitted that dependent Claims 19-20 are further patentable over the references cited as such dependent claims now depend from an allowable base claim. Accordingly, Applicants respectfully request that the current rejections of dependent Claims 19-20 under § 103(a) also be withdrawn.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

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Applicants appreciate the Examiner's careful consideration of this application and would welcome a telephone conference with the Examiner to expedite the processing of the patent application. Applicants' attorney, Barton Black, may be reached directly at (404) 881-4744.

Respectfully submitted,

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